

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-8 are currently pending. Claims 1, 7, and 8 have been amended by the present response. The amendments to the claims are supported by the originally filed specification and do not add new matter.¹

In the outstanding Office Action, Claims 1 and 6-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Application Publication No. 2004/0120421 to Filipovic and U.S. Application Publication No. 2003/0016761 to Min; and Claims 2-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Filipovic, Min, and U.S. Application Publication No. 2002/0176364 to Nakamura.

At the outset, Applicants note that this response is submitted in accordance with 37 C.F.R. §1.116 which after final rejection permits entering of amendments canceling claims, complying with any requirement of form expressly set forth in a previous Office Action, or presenting rejected claims in better form for consideration on appeal. The present response amends the claims to clarify features that were implied in the previously recited features. In particular, the amended claims clarify that the determining by the digital filter control unit occurs before the filtering of the digital signal by the digital filter, which features were implied by the previous recited feature of the digital filter control unit determining whether the filtering by the digital filter will increase distortion of the digital signal.

As such, Applicants submit that this amendment does not add new matter and does not raise new issues requiring further consideration and/or search. It is therefore respectfully requested that the present response be entered under 37 C.F.R. §1.116.

¹ See, e.g., Fig. 1 and the description thereof in Applicants' specification.

Applicants wish to thank the Examiner for the interview granted to Applicants' representative on December 15, 2010, at which time the outstanding rejections of the claims under 35 U.S.C. § 103(a) were discussed, as substantially summarized hereinafter. At the end of the discussion, the Examiner suggested that the independent claims should be amended to clarify that the determining by the digital filter control unit occurs before the filtering of the digital signal by the digital filter.

In view of the 35 U.S.C. § 103(a) rejections and the above-noted discussion, independent Claims 1, 7, and 8 have been amended to clarify that the determining by the digital filter control unit to disable the digital filter occurs *before* the filtering of the digital signal by the digital filter. Support for the above amendments can be found, for example, in Figure 1 and the description thereof in Applicants' specification.

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejections of independent Claims 1, 7, and 8 for the following reasons.

First, as discussed during the interview, Min describes a feedback system for a transmission system, in which the digital filter *always performs* filtering, and then the transmitted signal is analyzed to assess a roll-off factor by which the performance of the digital filter is to be adjusted. Therefore, in Min, (1) the apparatus is a *transmission* system, and (2) the above feedback analysis simply leads to *adjusting* the performance of the digital filter.

However, there is *no* disclosure in Min of (1) processing a *received* signal by the apparatus, or of (2) *disabling* the digital filter when determining directly from non-linearity of a power level or directly from non-linearity of an amplitude level of the received signal that the filtering by said digital filter will increase distortion of the received signal.

Thus, Min does *not* disclose or suggest that the determining to disable the digital filter occurs before the filtering of the digital signal by the digital filter, as clarified in independent Claim 1.

Second, as discussed during the interview, even assuming *arguendo* that Min's roll-off factor analyzer (130) can be properly combined with Filipovic's system, as asserted in the Office Action, the asserted combination would *not* meet all the elements recited in the independent claims.

As previously presented, Filipovic describes that the control unit (24) sends control signals to selectively enable or disable a digital filter (20) based on a current wireless protocol being supported.² Further, Filipovic describes that the control unit (24) enables or disables the digital filter (20) depending on whether the selected wireless protocol requires digital filtering in addition to the analog filtering in the analog filter (16).³ Finally, Filipovic describes that the selected wireless protocol requires digital filtering when a pass band filter in the analog filter (16) passes baseband signals of other wireless protocols in addition to the baseband signals of the selected wireless protocol.⁴

Therefore, in Filipovic, the control unit (24) enables or disables the digital filter (20) by determining whether digital filtering is required or not *based on the selected wireless protocol*. However, Filipovic's control unit (24) does *not* disable the digital filter (20) by making the determination directly from non-linearity of a power level or an amplitude level of the received signal.

Thus, even if Min's roll-off factor analyzer (130), which will simply analyze the (transmitted) signal and provide an adjustment to the performance of the digital filter to Filipovic, Filipovic's control unit (24) will still enable or disable the digital filter (20) by

² See Filipovic, paragraph [0029].

³ See Filipovic, paragraph [0029].

⁴ Id. at paragraph [0028].

determining whether digital filtering is required ***based on the selected wireless protocol***, and **not** on the adjustment determined by Min's roll-off factor analyzer (130).

Finally, the Office will appreciate that modifying Filipovic with Min, as asserted in the Office Action would be **improper** because the above combination would render Filipovic unsatisfactory for its intended purpose of making a determination to enable or disable Filipovic's digital filter based on ***the selected wireless protocol***. In particular, the Office's asserted combination of Filipovic and Min requires Filipovic's control unit to make the determination based on the ***output of the digital filter***, as described in Min, and **not** based on the ***selected wireless protocol***, as intended by Filipovic.

Thus, no matter how the teachings of Min and Filipovic are combined, the combination does **not** disclose or suggest the digital filter control unit to disable the filtering of the digital signal by said digital filter when determining directly from non-linearity of a power level or an amplitude level of the received signal that the filtering by said digital filter will increase distortion of the received signal, the determining occurring **before** the filtering of the digital signal by the digital filter, as clarified in independent Claim 1.

The above discussion regarding independent Claim 1 also applies to independent Claims 7 and 8, which recite analogous features in claims having different scopes.

Accordingly, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections of independent Claims 1, 7, and 8 (and associated dependent Claim 6) be withdrawn.

Regarding the rejections of dependent Claims 2-5 under 35 U.S.C. §103(a), Applicants respectfully submit that Nakamura fails to remedy the above deficiencies of Min

and Filipovic. Accordingly, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejections of dependent Claims 2-5 also be withdrawn.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAYER & NEUSTADT, L.L.P.



Eckhard H. Kuesters
Attorney of Record
Registration No. 28,870

Pranay K. Pattani
Registration No. 66,587